requirement, the application must simply indicate to persons skilled in the art that, as of the filing date, the applicant had invented what is now claimed. *See* Eiselstein, *supra* at 1039.

It is clear from the written description that Applicant had invented a system whereby control signals are sent from a first apparatus to a second apparatus, without first sending those control signals through a remote control device. Figure 1 of the specification shows set top box (STB) 10 receiving control signals CS1 from a remote control device (i.e., RC 1), translating control signals CS1 to control signals CS5, and transmitting control signals CS5 to other devices (e.g., VCR 20, TV 30, and HiFi 40). Figure 1 shows that control signals CS5 are received by the devices 20, 30, and 40. Indeed, the specification states, "the transmitter block TX of STB 10 transmits control signals CS5 that are used to control other apparatus 20, 30 and 40" *See* Applicant's specification, page 10, lines 13-15. Thus, the specification describes that the control signals that are transmitted by STB 10 are *the same* control signals that are received by the other apparatus, not control signals transmitted by some other intermediary device (e.g., a remote control).

The specification further states, "[i]f the RC1 received remote control signals are not associated with the STB 10 then the microcontroller of the STB 10 has to retrieve, from memory MEM, the stored remote control signals or codes to which the RC1 received signals correspond. The microcontroller...then outputs, via transmitter block TX of the STB, the non-RC1 reference remote control signals or codes...which operatively controls the corresponding apparatus." *See* Applicant's specification page 14, lines 23-32. This paragraph of the specification also makes clear that the inventors had, at the time of filing, envisioned an embodiment in which the control signals transmitted by the STB are the control signals that control the other apparatus, not control signals that are transmitted by some other device.

Though the specification does not, in literal words, state that control signals are sent from the first apparatus to the second apparatus without first transmitting the second control signals to the first remote control device, the specification makes clear to one of skill in the art that Applicant had, at the time of filing of the application, envisioned embodiments in which the STB sends signals to control the operation of other apparatus (e.g., a television), without sending those signals through some intermediary device (e.g., a remote control). Thus, the specification satisfies the written description requirement of 35 U.S.C. §112, first paragraph.

In view of the foregoing, it is respectfully requested that the rejection of claims 1 and 23-41 under 35 U.S.C. §112, first paragraph be withdrawn.

Rejections Under 35 U.S.C. §103

The Office Action rejects claims 1, 23-25, 28, 32, 33, and 41 under 35 U.S.C. §103 as purportedly being obvious in view of Goldstein (5,410,326) and either Levine (5,123,046) or Young (5,151,789). Applicant respectfully traverses each of these rejections, as one of skill in the art would not have been motivated to combine the references in the manner asserted in the Office Action.

The Office Action asserts that Goldstein discloses a video display device that receives programming information from a central station, stores the information, and sends the information to the remote controller. The Office Action further asserts that Goldstein discloses that the programming information may be used by the remote controller to operate another entertainment component, such as a VCR or stereo receiver.

The Office Action asserts that Levine and Young both teach a remote control system that downloads control commands, where the second control signals are sent from the first apparatus to the second apparatus without first transmitting the second control signals to the first remote control device.

The Office Action asserts that it would have been obvious to one of skill in the art at the time of the invention to have used the control concept taught by Levine and Young in the Goldstein system to reduce the operating burden on the user. The Office Action asserts that by using this "control concept" in the system Goldstein, "the device would function more automatically."

Applicants respectfully assert that the combination is improper. First, the Office Action has failed to establish why modifying Goldstein in the manner proposed in the Office Action "would reduce the operating burden on the user" and has failed to explain why "the device would function more automatically." Goldstein describes a system whereby control signals received at a cable converter over a broadcast medium are downloaded to a remote control device and used by the remote control device to control other devices. If Goldstein were to be modified in the manner proposed in the Office Action, the cable converter would, rather than provide the received control signals to the remote control, directly send these signals to control another

device. It is unclear why the latter system places less of an operating burden on the user and why this system functions more automatically. If the rejection is to be maintained, clarification is respectfully requested.

Second, the combination of Goldstein and either Levine or Young would have resulted in a system very different from what the Examiner asserts. Figure A below is a block diagram (produced by Applicant for this response) of Applicant's understanding of the system of Goldstein. In Goldstein, the cable converter receives signals over a broadcast medium which may include control signals for operating other devices (e.g., a VCR). The cable converter sends these control signals that were received over the broadcast medium to the remote control. The remote control may then use these signals to operate the VCR by sending these signals to the VCR.

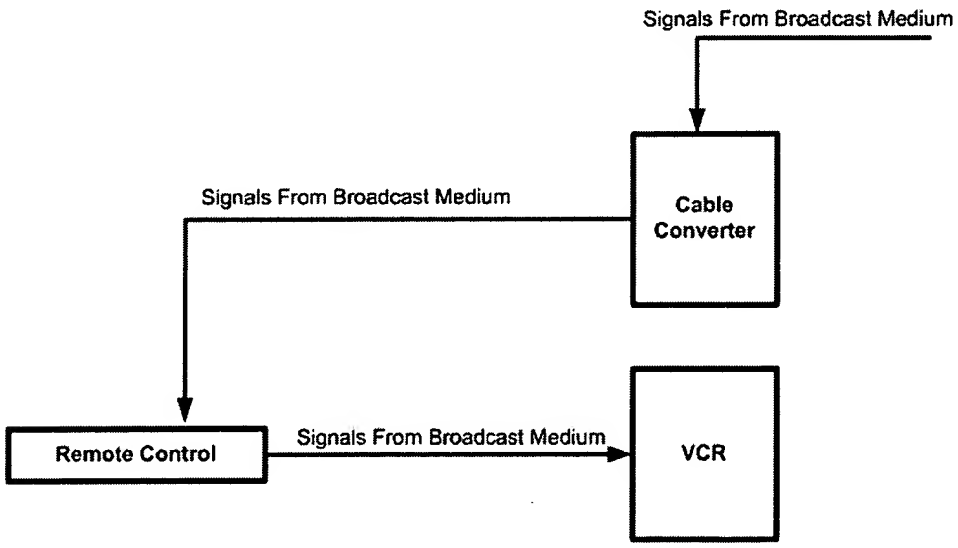

Figure A

Figure B is a block diagram (produced by Applicant for this response) of Applicant's understanding of the way in which the systems of Levine and Young operate. As shown in Figure B, a VCR receives a command from the remote control device to record a specific television program at a specific time. The VCR has a memory which is pre-programmed with codes for controlling the cable converter (*See* e.g., Cable Decoder RAM or ROM 46 in Figure 2

of Young and Decoders 46a, 46b, and 46c, in the sole figure of Levine). Indeed, Young explains that the cable remote emulator is either programmed to learn the cable decoder remote controller codes, which are then stored in the cable decoder code memory 46, or the memory 46 contains codes for the more popular cable decoder models. *See* Young, column 4, lines 54-61. Similarly, Levine explains that the video recorder includes three decoders (i.e., 46a, 46b, 46c) which convert the selection output signals from the microprocessor into one of three formats, each for use with a different make of cable box. A manual selector allows one of the three decoders to be selected. *See* Levine, column 4, lines 30-40.

When it is time to begin recording the television program, the VCR may send a command to tune the cable converter to the correct channel by sending a signal. The correct codes to change the channel for the particular make of cable converter are sent by using the codes that are either pre-programmed into the memory of the VCR (i.e., as explained in Young) or pre-selected from a limited set of codes via a manual selector (i.e., as explained in Levine).

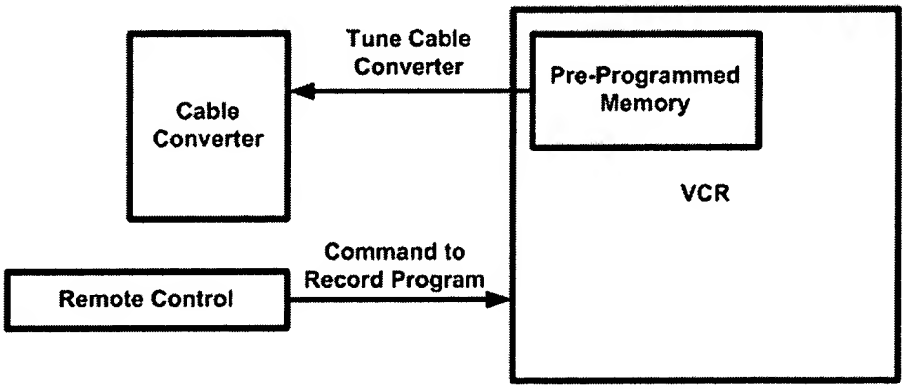

Figure B

Figure C is a block diagram (produced by Applicant for this response) of Applicant's understanding of an example of the system that the Office Action purports would result from combining the system in Figure A with the system in Figure B. The Office Action appears to assert that the combined system would operate as follows. The cable converter receives control codes for controlling another device (e.g., a VCR) over a broadcast medium and stores these

codes in memory. A remote control device sends a command to play a video cassette using codes that are recognizable by the cable converter, but not recognizable by the VCR. After the command is received by the cable converter, the cable converter recognizes that the command is a command for the VCR, determines the corresponding code for the VCR (i.e., the code that instructs the VCR to play a videocassette), accesses this code in the memory (where it was stored after reception from the broadcast medium), and transmits the code to the VCR.

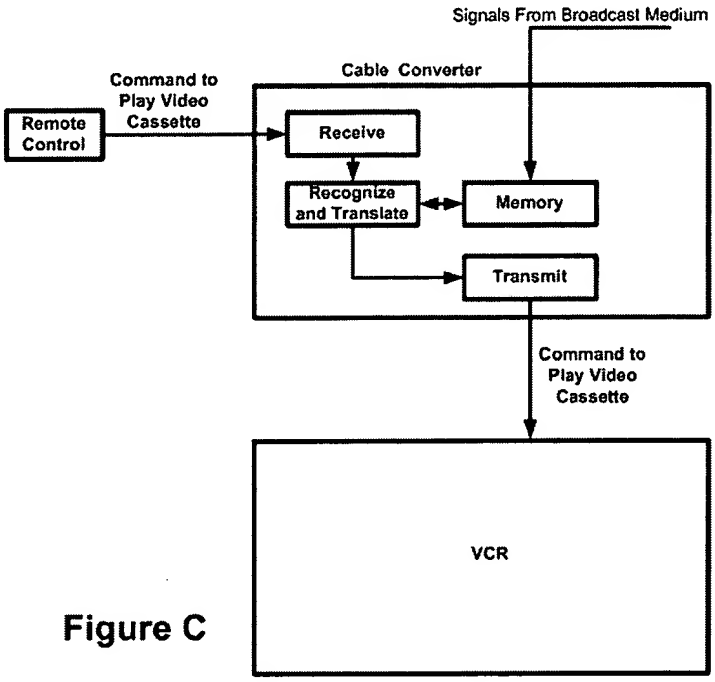

Figure C

Applicant respectfully disagrees that the combination of the system of Figure A and the system of Figure B would have resulted in the system of Figure C. Specifically, in the system of Figure C, the cable converter receives a command formatted according to one set of codes, determines that the command should be translated to another set of codes for use by a different device, and translates the command to the appropriate code or set of codes. Neither Goldstein, Levine, nor Young discloses or suggests performing any of these functions. Therefore, these functions would not be performed by a system derived from the combined teachings of Goldstein and Levine or Goldstein and Young. Thus, any system resulting from the combination of

Goldstein with either Levine or Young would function very differently from the system depicted in Figure C (i.e., the system that the Office Action asserts would result from the combination).

Goldstein does not disclose or suggest receiving a command formatted according to one set of codes, determining that a received command should be translated to another set of codes for use by a different device, and translating the command to the appropriate code or set of codes. As described above in connection with Figure A, the system of Goldstein does not perform any translation of a signal from one set of codes to another. Rather, the signals that are sent from the remote control device to operate another device always use the codes of the device for which they are intended.

In addition, neither Levine nor Young discloses or suggests determining that a received command should be translated to another set of codes for use by a different device, and translating the command to the appropriate code or set of codes. In the systems of Levine and Young, a VCR receives a command to record a specific channel during a specific time period (e.g., a command to record channel 49 from 3:00-4:00 PM). When the time comes to record the desired television program, the VCR sends a different command to the cable converter to tune the appropriate channel. This command is not a translation of the command to record the program from one set of codes to another, but rather is a separate command that is sent as a result for the command to record the television program. That is, the command received by the VCR from the remote control is not translated to a command which performs the same function, but uses a different set of codes. Instead, a completely different command is sent to the cable converter in response to the command from the remote control.

Thus, neither Goldstein, Levine, nor Young discloses or suggests receiving a command, determining a device for which the command is intended, translating the command from a first set of codes to a second set of codes that is recognizable by the device for which the command is intended, and transmitting the command according to the second set of codes. Therefore, any system resulting from the combined teachings of these references would not perform such functions (as performing such functions is not taught in any of the references).

Because the system that the Office Action asserts would result from the combination of Goldstein with either Levine or Young performs functions that are not disclosed, taught, or suggested, by any of the references, combining the references in the manner asserted in the

Office Action is improper. Accordingly, it is respectfully requested that the rejection of claims 1, 23-25, 28, 32, 33, and 41 be withdrawn.

The Office Action rejects claims 26, 27, 29, 30, 31, and 34-40 under 35 U.S.C. §103(a) as purportedly being obvious of Goldstein and either Levine or Young, as applied to claim 1, in combination with various other tertiary references (i.e., Miyagawa, Mills, and Geiger). Each of these rejections is respectfully traversed.

As should be clear from the foregoing, the combination of Goldstein with either Levine or Young is improper. Each of the rejections of claims 26, 27, 29, 30, 31, and 34-40, relies on the above-discussed combination of Goldstein with either Levine or Young, but modified to include additional features based on the purported teachings of one of the tertiary references. Thus, because the combination of Goldstein with either Levine or Young is improper, each of these rejections is also improper. Accordingly, it is respectfully requested that the rejections of claims 26, 27, 29, 30, 31, and 34-40 be withdrawn.

CONCLUSION

In view of the foregoing remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this Request for Reconsideration, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge the deficiency to Deposit Account No. 23/2825.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this document is being placed in the United States mail with first-class postage attached, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 9, 2006.

Eileen MacKenzie

Attorney Docket No.: S1022.80152US00
Date: March 9, 2006
X02/25/06X

Respectfully submitted,

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